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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/780,434 | 02/17/2004 | Ami Hasson | Ha-3 | 1560 |
| 25895 | 7590 | 03/15/2006 | EXAMINER | |
| ROBERT L STONE PC 13 MEADOWLARK LN EAST BRUNSWICK, NJ 08816 | | | POLLOCOFF, STEVEN B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3728 | |

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/780,434 | HASSON, AMI | |
| | Examiner | Art Unit | |
| | Steven B. Pollicoff | 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 February 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 17 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "foundation" of claim 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 11 and 12 recites the limitation "said object" in line 1 of claim 11 and line 2 of claim 12. There is insufficient antecedent basis for this limitation in the claims. For examination purposes, examiner will interpret claims 11 and 12 as depending from claim 10. As to claim 13, it is unclear as to what applicant means when referring to "said article comprises a disk." Is the article shaped like a disk or is the disk in addition to the article or is the disk a sealing disk as disclosed in the specification? For examination purposes, examiner will interpret the claim to mean that the article is shaped as a disk. As to claim 16, it is unclear how the packaging is pieced together. Does the packaging have connecting, interlocking means or do the sides of the packaging sit flush against one another or is the packaging just arranged close to one another for a complete object? For examination purposes, examiner will interpret the claim to mean that the packaging can be arranged close to one another to form a complete design. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Singer (US Pat No 6,085,919).

As to claim 1, Singer discloses a method of promoting sales of a product (Singer column 1, lines 12-15) by providing a plurality of articles (column 3, lines 6-9 and more specifically referring to the "pieces of puzzles") combinable with one another and introducing one of said articles into a packaging (i.e. container placed on a bottle cap; see also Column 3, lines 9-11) of each unit of said product and wherein said articles (pieces of puzzles) which are retrievable from said packaging can be combined together to form a design. The puzzle pieces will inherently combine and form a design.

As to claim 2, it is inherent that the design of the puzzle pieces is a pre-selected design and each of said articles (puzzle pieces) constitutes part of said design.

As to claim 3, it is inherent that when consumers collect puzzle pieces and piece them together, they are the ones in fact creating the design from the plurality of articles.

As to claim 4, it is inherent that articles such as puzzle pieces disclosed in Singer are shaped for being pieced together into a complete design.

As to claim 14, Singer discloses that the packaging comprises a bottle cap (Fig 1 and 2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 4-12,15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer (US Pat No 6,085,919) in view of Rainey (US Pat No 5,472,199).

As to claims 4-12, while Singer is silent as to the specifics of the puzzle pieces, Rainey discloses that individually collected puzzle pieces are shaped for being pieced together into a complete design so that others know that the collection is complete (Rainey Fig 2; column 1, lines 4-48), that a puzzle piece bears part of a design (Fig 3) and that the puzzle pieces, when collected and pieced together, are in the form of a jigsaw puzzle (Fig 2). Rainey also discloses that selecting a design which is a picture of creative interest enhances long term collection of the articles (column 5, lines 30-50), that the design is a picture that has artistic value to someone, that it can be a trademark (notice the Arby's trademark in Fig 1 reference number 18) or a 3 dimensional object (i.e the car in Fig 2), that a 3 dimensional puzzle piece (in the form of a pin or alternatively that all puzzle pieces have thicknesses, lengths and widths) enhances long term collection of all said articles shaped as matching parts (Fig 2) and that the article

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(i.e. puzzle piece) is shaped as part of the object to be created from the plurality of articles (once collected) (Fig 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the puzzle pieces of Singer to include puzzle pieces that are shaped to be pieced together into a complete design, to include puzzle pieces that bear part of the design and in jigsaw form, to include puzzle pieces that have design (including trademarks) and 3 dimensional properties that enhance long term collection, and finally to include puzzle pieces shaped as part of the object to be created from the plurality of puzzle pieces collected, as taught by Rainey, for the purpose of the pieces having collectible value (column 5, lines 52-61).

As to claim 15, Singer does not disclose providing a foundation for the puzzle pieces to be combined into the design. However, Rainey discloses providing a display board (foundation) on which the puzzle pieces can be combined to complete a design (column 5, lines 6-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to enhance the Singer product marketing method of providing puzzle pieces in bottle caps to be collected to further include a foundation for the individual puzzle pieces to be placed on, as taught by Rainey, so that an overall pictorial image can be formed once all of the puzzle pieces have been collected.

As to claim 16, while Singer does not disclose that the packaging is shaped for piecing together with a plurality of complementary packaging into a complete object, it would have been obvious to one of ordinary skill in the art to arrange the packaging to sit next/close to each other such that a design can be formed from the arrangement of the complementary packaging.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singer (US Pat No 6,085,919) in view of Hornsby, Jr., (US Pat No 4,007,936).

As to claim 13, Singer does not explicitly disclose that the article is shaped as a disk. However, Hornsby discloses that the article is shaped as a disk (Hornsby column 1, lines 64-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the shape of the Singer article disposed in the container to take the form of a disk, as taught by Hornsby, to better fit within the cap or lid of the bottle.

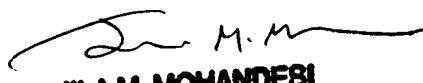
Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Boehm et al., (US Pat 5,819,976) discloses a bottle cap with an enclosure for promotional items.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JILA M. MOHANEDI
PRIMARY EXAMINER

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